

REMARKS

Applicants have addressed a number of specific questions to the Examiner in requests for clarification. The Examiner has not responded to these questions so far in the prosecution. Applicants respectfully request that the office action be re-issued with their questions answered.

ART REJECTIONS

The art rejections are respectfully traversed.

Any of the Examiner's rejections and/or points of argument that are not addressed below or in the incorporated comments would appear to be moot in view of the following. Nevertheless, Applicants reserve the right to respond to those rejections and arguments and to advance additional arguments at a later date. No arguments are waived and none of the Examiner's statements are conceded.

The prior arguments are incorporated by reference and supplemented as follows. The Examiner says that Applicants have not pointed to structural differences. Applicants respectfully submit that this is not the case and request reconsideration of this position. Applicants have pointed to a number of specific structural differences.

Claim 8

The Examiner states that the etched portion of the substrate forms a frame in Bachman. Applicants respectfully submit that the Examiner mischaracterizes the

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reference – at least so far as Applicants can discern based on the cited sections.

Paragraph 30 (and also 5 and 17-20) clarify that the film is connected to a retaining element along with an intermediate layer. The film itself does not form a frame. The higher temperature/pressure conditions in the x-ray tube require the intermediate layer and supplementary frame, which are not needed in the gas discharge lamp. Applicants accordingly respectfully submit that the Examiner has failed to make a *prima facie* case against this claim.

Claim 9

The Examiner points to paragraph 29 of Bachman as showing the foil brazed to a frame. Applicants respectfully submit that the Examiner mischaracterizes the reference – at least so far as Applicants can discern based on the cited sections. The foil is glued or fused to an intermediate layer, which then in turn is connected to a retaining element. Again, the foil cannot be directly attached to the frame in Bachman, because the conditions are more extreme in the x-ray environment and the intermediate layer is required for temperature buffering. Applicants accordingly respectfully submit that the Examiner has failed to make a *prima facie* case against this claim.

Claim 10

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Again, the Examiner points to paragraph 29 of Bachman as showing the foil adhered to a frame. Applicants respectfully submit that the Examiner mischaracterizes the reference – at least so far as Applicants can discern based on the cited sections. Applicants find the foil adhered to an intermediate material, which then is connected to the retaining element. The foil does not appear to be adhered to the frame. Applicants accordingly respectfully submit that the Examiner has failed to make a *prima facie* case against this claim.

Claim 1 (&11 &12)

The prior comments are incorporated by reference. The following structural differences were previously discussed, but are repeated here.

Claim 1 recites a discharge vessel and an electron source. Applicants are not finding a discharge vessel in Bachman. Instead, it appears that x-rays are emitted from a liquid metal circulation system 22. The x-rays then pass back through into the same evacuated chamber where the source is located. The window is therefore a two-way window.

It would not be obvious to combine this structure with the structure of Wieser, which has a discharge vessel and requires only a one-way foil. One of ordinary skill in the art would not be motivated to look at the x-ray arts to improve a gas discharge

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lamp, for the reasons given in the prior office action, and because the physical structures around the window are so different in the two contexts.

These same arguments apply to claims 11 and 12.

Claims 11 & 12

Applicants respectfully disagree with the Examiner's not considering the "adapted to perform" language. The following is quoted from the MPEP

2111.04 "Adapted to," "Adapted for," "Wherein," and "Whereby"

Clauses [R-3]

Claim scope is not limited by claim language that suggests or makes optional but does not require steps to be performed, or by claim language that does not limit a claim to a particular structure. However, examples of claim language, although not exhaustive, that may raise a question as to the limiting effect of the language in a claim are:

- (A) "adapted to" or "adapted for" clauses;
- (B) "wherein" clauses; and
- (C) "whereby" clauses.

The determination of whether each of these clauses is a limitation in a claim depends on the specific facts of the case. In *Hoffer v. Microsoft Corp.*, 405 F.3d 1326, 1329, 74 USPQ2d 1481, 1483 (Fed. Cir. 2005), the court held that when a "'whereby' clause states a condition that is material to patentability, it cannot be ignored in order to change the substance of the invention." *Id.* However, the court noted (quoting *Minton v. Nat'l Ass'n of Securities Dealers, Inc.*, 336 F.3d 1373, 1381, 67 USPQ2d 1614, 1620 (Fed. Cir. 2003)) that a "'whereby' clause in a method claim is not given weight when it simply expresses the intended result of a process step positively recited." *Id.*<

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As this section clarifies, “adapted to” clauses are not to be universally ignored. They must be considered in context and in light of the facts. Here this is a structural limitation material to patentability, not merely an intended result. Therefore the language cannot be ignored, per MPEP 2111.04

Claims 6 & 7

The following text is quoted from the prior amendment

In rejecting these claims, the Examiner states that cathode 62 has particular properties. *Applicants are not finding where the reference says that this cathode has those properties, nor has the Examiner elucidated this point. Clarification is accordingly respectfully requested.* [emphasis added]

The Examiner has failed to answer Applicants’ question here. Applicants respectfully submit that this is improper.

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Claim 16

The following text is quoted from the prior amendment

The Examiner states that the Uemura reference teaches using carbon nanotubes to widen the beam; BUT the section cited by the Examiner does not appear to say that the beam is widened, but rather concentrated.

Applicants respectfully request that the Examiner respond on this point.

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Applicants respectfully submit that they have addressed each issue raised by the Examiner — except for any that were skipped as moot — and that the application is accordingly in condition for allowance. Allowance is therefore respectfully requested.

Respectfully submitted,

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